

Notice of Allowability

Application No.

10/080,874

Examiner

Stephen Gucker

Applicant(s)

WALKER ET AL.

Art Unit

1649

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 7/13/05.
2. ☒ The allowed claim(s) is/are 14, renumbered as claim 1.
3. ☒ The drawings filed on 22 February 2002 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/029,535.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material

5. ☐ Notice of Informal Patent Application (PTO-152)

6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____

7. ☒ Examiner's Amendment/Comment

8. ☒ Examiner's Statement of Reasons for Allowance

9. ☐ Other _____


JANET L. ANDRES
SUPERVISORY PATENT EXAMINER

EXAMINER'S AMENDMENT & REASONS FOR ALLOWANCE

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1649.

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Michelle A. Klein and Thomas J. Kowalski on 8/10/05.

An examiner's amendment to the record appears below.

In the specification:

Page 1, line 2, deleted "allowed" and "Application Serial".

Page 1, line 2, after "U.S." inserted: --Patent--.

Page 1, line 3, deleted "09/029,535,".

Page 1, line 3, before "filed" inserted: --6,368,816--.

Page 1, line 7, deleted "Application Serial" and "09/029,535".

Page 1, line 7, before "No." inserted: --Patent--.

Page 1, line 7, after "No." inserted: --6,368,816--.

Page 1, line 9, deleted "Attorney docket numbers 674543-2001.2, 674543-2001.4,".

Page 1, line 9, inserted after "assigned, (":

--U.S. Application Serial No. 10/080,875, U.S. Patent No. 6,838,253--.

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Page 1, line 10, deleted "674543-2001.5 and 674543-2001.6).".

Page 1, line 10, inserted: --U.S. Application Serial Nos. 10/081,787 and 10/080,876).--.

In the claims:

In claim 14, line 3, deleted: "a human or"

3. The following is an examiner's statement of reasons for allowance: the closest prior art of record was Lakshmi et al. and Gomez-Sanchez et al. The instant claim has been amended to recite that the instant method be performed by using neuronal whole cells in culture (for support, see the specification at page 20, lines 33-35, and page 22, line 2, for example) which excludes both Lakshmi et al. and Gomez-Sanchez et al. as being anticipatory prior art references. Furthermore, the prior art of record does not fairly suggest the instant invention because of the unexpected result disclosed by the instant application that the 11-Beta HSD1 exhibits only reductase activity in whole cells, but exhibits both dehydrogenase and reductase activity in tissue homogenates or in its isolated form (see pages 21-22 of the specification). Because of the unidirectionality of the enzyme reaction in neuronal whole cells, as opposed to bidirectionality that has already been observed *in vitro*, the instant method has clinical utility as discussed in the specification on page 22.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technical Center 1600 general number which is (571) 272-1600.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (571) 272-0883. The examiner can normally be reached on Monday to Friday from 0930 to 1800. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached at (571) 272-0867. The fax phone number for this Group is currently (571)-273-8300.



Stephen Gucker

August 12, 2005